

REMARKS

Claims 1, 2, 4, 5 and 7-33 are pending in the application and are the subject of the present Office Action. Each of the rejections set forth in the Office Action are addressed below.

Double Patenting Rejections

Claims 1, 2 4, 5, and 7-33 are provisionally rejected under 35 USC 101 as claiming the same invention as that of claims 1, 2, 4, 5 and 7-33 of co-pending application serial number 11/541,821. This rejection is a provisional rejection since the involved claims have not yet been patented.

Applicants acknowledge the provisional rejection and note that a restriction requirement has been issued in Applicants' continuation application serial number 11/541,821. Applicants intend to file a response to that restriction requirement in due course so as prosecute claims in that application which are not coextensive in scope with the claims pending in the instant application.

Claims 1, 23-25 and 31-32 were provisionally rejected on grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 7-10, 12-13, 19-22, 24-39, 42-48, 58-67, 81-82 of co-pending application serial number 11/541,828. Claims 1 and 23-33 were also provisionally rejected on grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 7-10, 12-22, 24-39, 42-48, 58-70, and 81-82 of co-pending application serial number 12/283,351. These rejections are provisional in nature since the involved claims have not yet been patented.

Applicants acknowledge the provisional rejections and request the rejections be held in abeyance until such time as a notice of allowance is issued for the subject claims, and Applicants can evaluate the filing any suitable terminal disclaimer which may be needed.

Section 112 Rejections

Claims 1, 2, 4, 5, and 7-33 were rejected under Section 112, second paragraph as being indefinite. Applicants respectfully disagree with the rejection. The subject claims, however, have been amended to clarify the language of the subject claims, and it is believed the amendments sufficiently address the issues raised in the Office Action. It is believed that the clarifying language does not alter the scope of the embodiments as originally presented and claimed in the application.

Claims 1, 9, and 22-33 were rejected under Section 112, first paragraph, as not complying with the written description requirement. Applicants respectfully traverse the rejection.

Applicants' disclosure provides numerous working examples of Apo-2 ligand variant polypeptides along with a comprehensive description of the native human Apo-2 ligand polypeptide and how such polypeptides may be mutated and tested for biological properties and activities. The experimental data provided in the disclosure clearly demonstrates Applicants were indeed in possession of the claimed embodiments. Withdrawal of this rejection is respectfully requested.

Claims 1, 2, 4, 5, and 7-33 were rejected under Section 112, first paragraph, as not providing enablement for certain embodiments encompassed by the claims. Applicants respectfully traverse the rejection.

Applicants have amended the subject claims, as shown above, without prejudice or acquiescence in an effort to advance the prosecution of this application in a more expeditious manner. It is believed that the claims are enabled across the full scope of the claimed subject matter. Withdrawal of the rejection is respectfully requested.

Section 102 Rejections

Claims 2, 4, 5, 8, 10, 12, 13, 16, 17, 19, 20, 26-31 and 33 were rejected as being anticipated under Section 102(b) by Hymowitz et al. Applicants respectfully traverse the rejection.

Hymowitz et al. describe use of alanine-scanning techniques to map regions of the Apo-2 ligand polypeptide (Apo2L/TRAIL) which contact its receptor. Hymowitz et al. also describe the trimeric structure for Apo-2 ligand polypeptide which is coordinated by a single zinc ion. Hymowitz et al. do not teach or even mention the Apo-2 ligand variants provided for by the present application, nor does Hymowitz et al. disclose that such variants can retain desired biological properties such as receptor binding or apoptotic activity.

To anticipate under Section 102, a reference must teach all the elements of the claimed inventions and must do so in a way to enable those skilled in the art. As discussed above, it is submitted that the Hymowitz et al. reference does not satisfy either of these anticipation requirements. Withdrawal of the rejection is respectfully requested.

Respectfully submitted,  
GENENTECH, INC.

July 7, 2009

By: Diane L. Marschang  
Diane L. Marschang  
Reg. No. 35,600  
Telephone No. (650) 225-5416